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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,530	07/10/2003	Yen-Fu Chen	AUS920030522US1	3554
45371 7590 01/24/2007 IBM CORPORATION (RUS) c/o Rudolf O Siegesmund Gordon & Rees, LLp 2100 Ross Avenue Suite 2600 DALLAS, TX 75201			EXAMINER NEWAY, SAMUEL G	
			ART UNIT 2626	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/617,530

Applicant(s)

CHEN ET AL.

Examiner

Samuel G. Neway

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/10/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is responsive to the Application filed on July 10, 2003.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 – 30 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 16, and 30 - 45 of copending Application No. 10/617,526. Although the conflicting claims are not identical, they are not patentably distinct from each other because the above-mentioned claims of copending Application No. 10/617,526 anticipate the claims of the current Application.

Current Application	Co-pending Application 10/617,526
<p>1. A method comprising: using Unicode to determine a Traditional Chinese character equivalent of a Simplified Chinese character.</p> <p>2. The method of claim 1 further comprising: accepting the Simplified Chinese character as user input, wherein the Simplified Chinese character is encoded in GB2312 or Unicode.</p> <p>3. The method of claim 1 further comprising: translating the Simplified Chinese character from GB2312 to Unicode.</p> <p>4. The method of claim 1 further comprising: accessing a conversion table to determine the Traditional Chinese character.</p> <p>5. The method of claim 4 wherein the conversion table is a JAVA hashtable.</p> <p>6. The method of claim 1 wherein Traditional Chinese character is determined without the use of an intermediate language.</p> <p>7. The method of claim 1 further comprising: displaying the Simplified Chinese character and the Traditional Chinese character.</p>	<p>1. A method comprising: using Unicode to determine a Traditional Chinese character equivalent of a Simplified Chinese character; and using Unicode to translate the Simplified Chinese character into accented Pin Yin word and an English word.</p> <p>2. The method of claim 1 further comprising: accepting the Simplified Chinese character as user input, wherein the Simplified Chinese character is encoded in GB2312 or Unicode.</p> <p>3. The method of claim 1 further comprising: translating the Simplified Chinese character from GB2312 to Unicode.</p> <p>4. The method of claim 1 further comprising: accessing a conversion table to determine the Traditional Chinese character.</p> <p>5. The method of claim 4 wherein the conversion table is a JAVA hashtable.</p> <p>7. The method of claim 1 wherein Traditional Chinese character is determined without the use of an intermediate language.</p> <p>8. The method of claim 1 further comprising: displaying the Simplified Chinese character, the Traditional Chinese character, the accented Pin Yin word, and the English word.</p>

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1 – 3, 7 – 10, 14, 16 – 18, 22 – 25, and 29 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5 – 7, 26, 30 – 32 of copending Application No. 10/631,070. Although the conflicting claims are not identical, they are not patentably distinct from each other because the above-mentioned claims of copending Application No. 10/631,070 anticipate the claims of the current Application.

Current Application	Co-pending Application 10/631,070
<p>1. A method comprising: using Unicode to determine a Traditional Chinese character equivalent of a Simplified Chinese character.</p> <p>2. The method of claim 1 further comprising: accepting the Simplified Chinese character as user input, wherein the Simplified Chinese character is encoded in GB2312 or Unicode.</p> <p>3. The method of claim 1 further comprising: translating the Simplified Chinese character from GB2312 to Unicode.</p> <p>7. The method of claim 1 further comprising: displaying the Simplified Chinese character and the Traditional Chinese</p>	<p>1. A method comprising: searching a dictionary for an entry containing a Simplified Chinese word; using Unicode to determine a Traditional Chinese word equivalent of a Simplified Chinese word; and using Unicode to translate the Simplified Chinese word into accented Pin Yin word and an English word.</p> <p>5. The method of claim 1 further comprising: accepting the Simplified Chinese word as user input, wherein the Simplified Chinese word is encoded in GB2312 or Unicode.</p> <p>6. The method of claim 1 further comprising: translating the Simplified Chinese word from GB2312 to Unicode.</p> <p>7. The method of claim 1 further comprising: displaying the Simplified Chinese word, the Traditional Chinese word, the accented</p>

character.	Pin Yin word, and the English word; and wherein the font size of the Simplified Chinese word and the font size of the Traditional Chinese word is user configurable.
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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 16 – 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 16 – 30 recite the phrases “program product” and “computer-usable medium”; these phrases are not defined in the specification and it is not clear what they are meant to cover.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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8. Claims 1 – 6, 8 – 13, 15 – 21, 23 – 28, and 30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1 – 6, 8 – 13, 15 – 21, 23 – 28, and 30 appear to be directed to an abstract idea rather than a practical application of the idea. The claims do not result in a physical transformation nor do they appear to provide a tangible result. For example, merely determining the Traditional Chinese character equivalent to a Simplified Chinese character is nothing more than a thought or a computation within a processor. It fails to use or make available for use the result of the determination to enable its functionality and usefulness to be realized.

One possible practical application of the abstract idea is put forth in claim 7 where the result is displayed.

9. Claims 16 – 30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 16 – 30 recite the limitation “wherein the computer usable medium comprises instructions”. These instructions should be capable of being executed by a computer in order to realize the computer program’s functionality.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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11. Claims 1 – 4, 6 – 11, 13 – 19, 21 – 26, and 28 – 30 are rejected under 35

U.S.C. 102(b) as being anticipated by

<http://web.archive.org/web/20001204034200/http://www.mandarintools.com/>.

Claim 1:

The Chinese-English Dictionary link from

<http://web.archive.org/web/20001204034200/http://www.mandarintools.com/> discloses a method comprising:

using Unicode to determine a Traditional Chinese character equivalent of a Simplified Chinese character ("searches can be conducted by Chinese (using either the GB, Big5, or Unicode encodings), ... results will show the Chinese word", page 1. Note that the Chinese word can be selected to be either Simp. Chinese (GB) or Trad. Chinese (Big5) as shown on top of page 1).

Claim 2:

Chinese-English Dictionary discloses the method of claim 1 further comprising: accepting the Simplified Chinese character as user input, wherein the Simplified Chinese character is encoded in GB2312 or Unicode ("return the results in GB ... or Unicode", page 1).

Claim 3:

Chinese-English Dictionary discloses the method of claim 1 further comprising: translating the Simplified Chinese character from GB2312 to Unicode ("return the results in GB ... or Unicode", page 1).

Claim 4:

Chinese-English Dictionary discloses the method of claim 1 further comprising: accessing a conversion table to determine the Traditional Chinese character ("searches can be conducted by Chinese (using either the GB, Big5, or Unicode encodings), ... results will show the Chinese word", page 1. Note that a conversion table is inherent in the determination of equivalent characters).

Claim 6:

Chinese-English Dictionary discloses the method of claim 1 wherein Traditional Chinese character is determined without the use of an intermediate language ("searches can be conducted by Chinese (using either the GB, Big5, or Unicode encodings), ... results will show the Chinese word", page 1. Note that the Chinese word can be selected to be either Simp. Chinese (GB) or Trad. Chinese (Big5) as shown on top of page 1).

Claim 7:

Chinese-English Dictionary discloses the method of claim 1 further comprising: displaying the Simplified Chinese character and the Traditional Chinese character ("results will show the Chinese word", page 1. Note that the Chinese word can be selected to be either Simp. Chinese (GB) or Trad. Chinese (Big5) as shown on top of page 1).

Claims 8 – 11, and 13 – 15:

Claims 8 – 11, and 13 – 15 are similar in scope and content to claims 1 – 4, and 6 – 7; therefore claims 8 – 11, and 13 – 15 are rejected with the same rationale.

Claims 16 – 19, and 21 – 22:

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Claims 16 – 19, and 21 – 22 are similar in scope and content to claims 1 – 4, and 6 –7; therefore claims 16 – 19, and 21 – 22 are rejected with the same rationale.

Claims 23 – 26, and 28 – 30:

Claims 23 – 26, and 28 – 30 are similar in scope and content to claims 1 – 4, and 6 –7; therefore claims 23 – 26, and 28 – 30 are rejected with the same rationale.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 5, 12, 20, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over

<http://web.archive.org/web/20001204034200/http://www.mandarintools.com/> in view of Hughes (“1ICT3 Computer Science Sample Paper I”, 1998, University of Dublin)

Claim 5:

Chinese-English Dictionary discloses the method of claim 4, but does not explicitly disclose using a Java hashtable.

Hughes discloses a conversion table for Morse code stored in a Java hashtable (“The conversion table for Morse code can be stored in a Java Hashtable object”, page 4, question 6).

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Therefore it would have been obvious to one with ordinary skill in the art at the time of the invention to use a Java hashtable as the conversion table in Chinese-English Dictionary because Java is able to run on any platform.

Claims 12, 20, and 27:

Claims 12, 20, and 27 are similar in scope and content to claim 5; therefore they are rejected with the same rationale.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Xing (US PGPub 2003/0115040) discloses a method of translating a domain name entered in one of many different languages into its corresponding English domain name using Unicode.

Tan et al. (USPN 6,314,469) discloses a method of identifying the encoding type of a domain name, converting the encoding to Unicode and translating the Unicode representation to an ASCII representation.

Zhong (USPN 5,319,552) discloses a method of converting Pin Yin into corresponding Zhu Yin (Traditional Chinese) and vice versa using conversion tables.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel G. Neway whose telephone number is 571-270-1058. The examiner can normally be reached on Monday - Friday 8:30AM - 5:30PM EST.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R Hudspeth can be reached on 571-272-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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